

DIVISION

Docket No. 97-2RCE

101 NOV -9 PM 5:27 PATENT

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BY:

Suzanne Shadley  
Suzanne Shadley

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Schultz et al.

Confirmation No. 2173

Serial No.: 08/847,967

Group Art Unit: 1639

Filed: 4/22/97

Examiner: Epperson, Jon

For: The Combinatorial Synthesis of Novel Materials

Mail Stop 16  
Director of the USPTO  
P.O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Sir:

Transmitted herewith (check all that apply):

- |  |  |
|--|--|
| <input type="checkbox"/> Preliminary Amendment             | <input type="checkbox"/> Supplemental Information Disclosure Statement |
| <input type="checkbox"/> Response/Amendment                | <input type="checkbox"/> Petition Under 37 CFR 1.97(d)(2)              |
| <input type="checkbox"/> Response/Amendment After Final    | <input type="checkbox"/> Formal Drawings                               |
| <input type="checkbox"/> Supplemental Amendment            | <input type="checkbox"/> Declaration Under 37 CFR 1.131                |
| <input type="checkbox"/> Affidavits/Declarations           | <input type="checkbox"/> Declaration Under 37 CFR 1.132                |
| <input type="checkbox"/> Declaration and Power of Attorney | <input type="checkbox"/> Terminal Disclaimer                           |
| <input type="checkbox"/> Supplemental Declaration          | <input type="checkbox"/> Small Entity Statement                        |
| <input type="checkbox"/> Associate Power of Attorney       | <input checked="" type="checkbox"/> Request for Refund                 |
| <input type="checkbox"/> Change of Correspondence Address  | <input type="checkbox"/> Appeal  |
| <input type="checkbox"/> Associate Power of Attorney       | <input type="checkbox"/> Petition                                      |
| <input type="checkbox"/> Response to Missing Parts         | <input type="checkbox"/> Status Letter                                 |

to be filed in the above-identified patent application.


☒ No fee is required.

☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to Deposit Account No. 50-0496.

A duplicate copy of this Transmittal Letter is transmitted herewith.

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Respectfully submitted,



Paul A. Stone

Reg. No. 38,628

Attorney for Applicant(s)

Date: Nov. 2, 2004

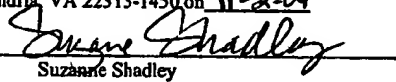
Symyx Technologies, Inc.  
3100 Central Expressway  
Santa Clara, California 95051  
Tel.: (408) 773-4027  
Fax: (408) 773-4029

Docket No. 97-2RCE  
PATENT

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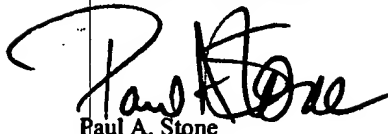
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A duplicate copy of this Transmittal Letter is transmitted herewith.

Respectfully submitted,



Paul A. Stone  
Reg. No. 38,628  
Attorney for Applicant(s)

Date:

Nov. 3, 2004

Symyx Technologies, Inc.  
3100 Central Expressway  
Santa Clara, California 95051  
Tel.: (408) 773-4027  
Fax: (408) 773-4029

Docket No. 97-2RCE  
**PATENT**

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BY: Suzanne Shadley  
Suzanne Shadley

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Schultz et al.

Confirmation No. 2173

Serial No.: 08/847,967

Group Art Unit: 1639

Filed: 4/22/97

For: The Combinatorial Synthesis of  
Novel Materials

Examiner: Epperson, Jon

**Mail Stop 16  
Director of the USPTO  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**REQUEST FOR REFUND  
(37 C.F.R. 1.28(a))**

Sir:

Applicants filed a Request for Continued Examination on May 11, 2004 and erroneously paid large fees. Applicants filed a second Request for Continued Examination on October 21, 2004 and again erroneously paid large fees.

On November 26, 1997 Applicants filed a Verified Statement Claiming Small Entity Status and properly paid small entity filing fees in response to the Notice of Missing Parts. A copy of the statement is attached for reference. Small entity fees should also have been paid for both of the RCEs filed in this application.

Applicants are requesting a refund in the amount of \$385.00 and \$395.00, for a total refund of \$780.00. This request for refund is made within six months of the date the large fees

Application Serial No. 08/847,967

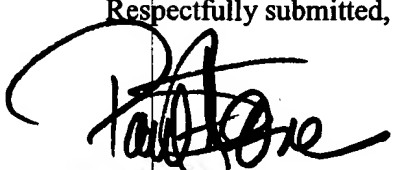
Docket No. 97-2RCE  
PATENT

were paid in this application.

Please make refund by crediting Deposit Account No. 50-0496 in the amount of \$780.00.

Respectfully submitted,

Date: Nov. 2, 2004

A handwritten signature in black ink, appearing to read 'Paul A. Stone', with a large, sweeping initial 'P'.

Paul A. Stone  
Registration No. 38,628

Symyx Technologies, Inc.  
3100 Central Expressway  
Santa Clara, CA 95051  
(408) 773-4026



Atty. Docket No. 016703-000800

VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY STATUS  
(37 CFR 1.9(f) & 1.27(c)) - SMALL BUSINESS CONCERN

Applicant or Patentee: ISY GOLDWASSER, et al.

Application or Patent No.: 08/847,967

Filed or Issued: April 22, 1997

Title: THE COMBINATORIAL SYNTHESIS OF NOVEL MATERIALS

I hereby declare that I am

- ☐ the owner of the small business concern identified below:  
☒ an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF SMALL BUSINESS CONCERN Symyx Technologies

ADDRESS OF SMALL BUSINESS CONCERN 3100 Central Expressway  
Santa Clara, CA 95051

I hereby declare that the above-identified small business concern qualifies as a small business concern as defined in 13 CFR 121.12, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees to the United States Patent and Trademark Office, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention, entitled THE COMBINATORIAL SYNTHESIS OF NOVEL MATERIALS by inventor(s) Isy Goldwasser, et al. described in

- ☐ the specification filed herewith  
☒ Application No. 08/847,967, filed April 22, 1997  
☐ Patent No. \_\_\_\_\_, issued \_\_\_\_\_

If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights in the invention is listed below\* and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern that would not qualify as a small business concern under 37 CFR 1.9(d), or a nonprofit organization under 37 CFR 1.9(e).

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING Isy Goldwasser

TITLE OF PERSON IF OTHER THAN OWNER V.P. Corporate Development

ADDRESS OF PERSON SIGNING Symyx Technologies  
3100 Central Expressway  
Santa Clara, CA 95051

SIGNATURE [Signature]

DATE 11/12/97

SMR 6/95

P:\DATA\PS\PTOD\BOW\69021



12/22/2004  
RCE

PTO/SB/30 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE  
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# REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,  
provides for continued examination of an utility or plant application  
filed on or after June 8, 1995.  
See The American Inventors Protection Act of 1999 (AIPA).

|                        |                       |
|------------------------|-----------------------|
| Application Number     | 08/847,967            |
| Filing Date            | 4/22/97               |
| First Named Inventor   | Isy Goldwasser et al. |
| Group Art Unit         | 1639                  |
| Examiner Name          | Epperson, Jon D.      |
| Attorney Docket Number | 97-2RCE3              |

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

**NOTE:** 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

## 1. Submission required under 37 C.F.R. § 1.114

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on \_\_\_\_\_  
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- iii. ☐ Other \_\_\_\_\_
- b. ☒ Enclosed
- i. ☐ Amendment/Reply 10/26/2004 GWORDOF1 00000048 500496 08847967
- ii. ☐ Affidavit(s)/Declaration(s) 01 FC:1801 790.00 DA
- iii. ☒ Information Disclosure Statement (IDS)
- iv. ☐ Other \_\_\_\_\_

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees

The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 50-0496
- i. ☒ RCE fee required under 37 C.F.R. § 1.17(e)
- ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_
- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

|                     |               |                                   |                  |
|---------------------|---------------|-----------------------------------|------------------|
| Name (Print / Type) | Paul A. Stone | Registration No. (Attorney/Agent) | 38,628           |
| Signature           |               | Date                              | October 21, 2004 |

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|                   |                 |      |                  |
|-------------------|-----------------|------|------------------|
| Name (Print/Type) | Suzanne Shadley | Date | October 21, 2004 |
| Signature         |                 |      |                  |

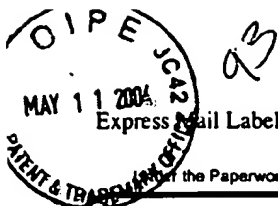
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Adjustment date: 12/22/2004 SDIRETA1  
10/26/2004 GWORDOF1 00000048 500496 08847967  
01 FC:1801 790.00 CR

12/22/2004 SDIRETA1 00000015 500496 08847967

01 FC:2801 395.00 DA





5-12-04

IFW & RCE  
1639

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PTO/SB/30 (08-00)

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| Application Number     | 08/847,967            |
| Filing Date            | 4/22/97               |
| First Named Inventor   | Isy Goldwasser et al. |
| Group Art Unit         | 1639                  |
| Examiner Name          | Epperson, Jon D.      |
| Attorney Docket Number | 97-2RCE2              |

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

|                   |               |                                   |              |
|-------------------|---------------|-----------------------------------|--------------|
| Name (Print/Type) | Paul A. Stone | Registration No. (Attorney/Agent) | 38,628       |
| Signature         |               | Date                              | May 10, 2004 |

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|-------------------|-----------------|------|--------------|
| Name (Print/Type) | Suzanne Shadley | Date | May 11, 2004 |
| Signature         |                 |      |              |

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05/13/2004 RNEBRAHT 00000063 500496 08847967  
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08847967

12/22/2004 SDIRETA1 00000014 500496

385.00 DA  
01 FC:2801

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